

REMARKS

A Petition for Extension of Time is being concurrently filed with this Amendment. Thus, this Amendment is being timely filed.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and present specification and the following remarks.

Status of the Claims

In the present Reply, claims 4, 7, 9-13 and 15 have been amended, and claims 14 and 16 have been canceled without prejudice or disclaimer of the subject matter contained therein. Claims 8 and 17-26 are withdrawn from consideration. Thus, claims 1-3, 15 and 17-26 are pending in the present application.

No new matter has been added by way of these amendments, because each amendment is supported by the present specification. For example, the amendments to claims 4 and 12 are to delete the process steps in this product claim. Also, the preferred ranges are deleted in claims 7 and 15. Further, claims 9-13 and 15 have been properly amended into "method" claims instead of the previously presented "use" claims.

The amendments to the present specification do not add new matter. These changes are editorial in nature and are minor in character. Applicants note that previous changes to the specification were made as shown in the Article 34 amended sheets (submitted June 25, 2004).

Based upon the above considerations, entry of the present amendments is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Rejections under 35 U.S.C. § 112, First Paragraph, § 101 and § 112, second paragraph (pages 2-3 of Office Action)

Claims 9-16 stand rejected under 35 U.S.C. § 112, first paragraph, as well as under 35 U.S.C. § 101 and 35 U.S.C. § 112, second paragraph, for recitation of a use and/or without setting forth process steps (see pages 2-3 of the Office Action). Applicants respectfully traverse.

Applicants respectfully refer the Examiner to the disputed claims as presented herein. Process steps are properly recited in the method claims. Further, “use” is no longer recited in these claims. Accordingly, reconsideration and withdrawal of these rejections are respectfully requested.

Issues under 35 U.S.C. § 102(b)

Claims 1-4 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tomita *et al.* '392 (U.S. Patent No. 5,543,392) (see pages 3-4 of the Office Action).

Also, claims 1-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Trumpler *et al.* (*Journal European Journal of Clinical Microbiology & Infectious Diseases*, Issue Vol. 8, No. 4 (April 1989)) (see pages 4-5 of the Office Action).

Applicants respectfully traverse and reconsideration is based on the following remarks.

In both rejections, the Examiner states that the claim language in the preamble of the disputed claims are not given patentable weight, and citing M.P.E.P. § 2111.02. However,

M.P.E.P. § 2111.02 also states such a determination is made on a case-by-case basis and that “there is no litmus test defining when a preamble limits the scope of a claim.” *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002). In the instant situation, for example, claim 1 recites: “A composition for improving lipid metabolism having lactoferrin as an active ingredient.” This is different from claiming, for example, “A composition having lactoferrin as an active ingredient.” Here, lactoferrin is the active ingredient to improve lipid metabolism. Thus, the claim preamble is “necessary to give life, meaning, and vitality” to the claim, and thus should be given patentable weight. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-1166.

In contrast, Tomita *et al.* '392 is directed to improving damage to the digestive tract (see the Abstract; column 3, lines 31-37); the Trumpler *et al.* reference is directed to avoiding infection in patients that received chemotherapy (see page 310, right column).

Further, Applicants note the disclosure in the present specification supporting Applicants' position. For instance, Applicants note pending claim 2 and page 26 of the present specification that shows how the claimed composition increases the HDL levels *in vivo*.

Accordingly, each of the cited references fails to disclose all claimed features and thus these rejections have been overcome. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Reconsideration and withdrawal of these rejections are respectfully requested.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 
Gerald M. Murphy, Jr.
Registration No.: 28,977
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant